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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,138	09/16/2003	Kenichi Kitayama	HONZ 2 00012	3991

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EXAMINER

ENGLE, PATRICIA LYNN

ART UNIT	PAPER NUMBER
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3612

DATE MAILED: 09/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/663,138

Applicant(s)

KITAYAMA ET AL.

Examiner

Patricia L Engle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/18/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Claim Objections*

1. Claim 18 is objected to because of the following informalities: In claim 18, line 1, "13" should be --17--. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-10, 13, 15-17 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ojanen (WO 02/066313A1).

Regarding claim 1, Ojanen discloses a tailgate assembly comprising a metal frame (105,131,103) having a reinforced cross-sectional shape(Fig. 7) with an inner side (side facing 23a) facing an associated vehicle's load-carrying bed and an outer side (side facing 121) opposite the inner side; and a skin (121) attached to the outer side of the frame. Regarding the limitation that the tailgate pivot on a horizontal axis and a vertical axis, this limitation is in the preamble and has been given little patentable weight. It has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self contained description of the structure not depending for completeness upon the introductory clause. Therefore the tailgate assembly only needs to be capable of pivoting on the vertical and horizontal axis. This is a known hinge assembly in the tailgate art and the tailgate of

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Ojanen would be capable of pivoting on both hinges if the proper hinge assembly were installed on the tailgate. Regarding the limitation that the frame is a stamped sheet metal frame, MPEP 2113 Product-by-Process Claims states that "If the product in the product-by-process claim is that same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process." The tailgate assembly is anticipated by Ojanen. The process by which the frame of the tailgate assembly is made is not a patentable distinction.

Regarding claim 13, Ojanen discloses a dual-mode vehicle closure structure comprising: a frame having a double-hat shape (105,103) including a raised section (upper portions of 103 and 105 in Fig. 7) and an inner flange and an outer flange flanking the raised section; a sheet molding compound structural cladding (23a) adjacent and connected to the raised section of the frame; and a skin (121) adjacent and connected to the outer flange of the frame.

Regarding claim 2, Ojanen discloses the tailgate assembly of claim 1 further including: a structural cladding (23a) attached to the inner side the frame.

Regarding claims 3, 15 and 16, Ojanen discloses the tailgate assembly of claim 2 wherein the structural cladding includes a corrugated section (50) to provide torsional and bending resistance.

Regarding claim 4, Ojanen discloses the tailgate assembly of claim 2 wherein the structural cladding formed of sheet molding compound which enables the cladding to be relatively lightweight (abstract).

Regarding claim 5, Ojanen discloses the tailgate assembly of claim 1 wherein the frame (103,105,131) having a reinforced cross-sectional shape includes a raised section (103,105)

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extending around an area adjacent a perimeter of the frame for increasing the stiffness of the frame and resisting bending of the frame when a load is applied thereto.

Regarding claim 6, Ojanen discloses the tailgate assembly claim 5 wherein the frame (103,105,131) further includes a peripheral flange (Fig. 7- 105 and 60,62 of 103) located between the raised section and the perimeter of the frame.

Regarding claims 7 and 8, Ojanen discloses the tailgate assembly of claim 6 wherein the skin (121) is attached to the peripheral flange (Fig. 9). MPEP 2113 Product-by-Process Claims states that "If the product in the product-by-process claim is that same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process." The skin being connected to the frame is anticipated by Ojanen. The process by which the skin and the frame are joined is not a patentable distinction.

Regarding claim 9, Ojanen discloses the tailgate assembly of claim 2 further including: a cap (203) connected cladding and skin along top side of the frame.

Regarding claim 10, Ojanen discloses the tailgate assembly of claim wherein the frame includes a reinforcing rib (Fig. 7, 105 discloses a rib) adjacent at least one edge of the frame.

Regarding claim 17, Ojanen discloses the dual mode vehicle closure structure of claim 13 further including: at least one stiffener (connection elements of 103 and 105 connecting the sides of the elements) connected to the frame reinforcing the frame.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 11, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ojanen.

Ojanen discloses the tailgate assembly of claim 10.

Ojanen does not disclose that the rib extends along each perimeter edge.

Ojanen does disclose that forming the parts by stamping would be more simple than extrusion. It would have been obvious to one of ordinary skill in the art to make the frame as a one piece member formed by stamping, which would result in the rib or embossed area extending along each perimeter edge of the frame (claims 11 and 12). The motivation would have been to simplify the manufacturing of the frame (stamping is more simple than extrusion and one piece members take less time to assemble than multi part members).

7. Claims 14 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ojanen in view of Smith (US Patent 2,806,735).

Ojanen discloses the tailgate of claims 1-13 and 15-17.

Ojanen does not disclose that the tailgate pivots about a horizontal and vertical axis.

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Harper discloses a tailgate which pivots about a horizontal axis and a vertical axis.

Ojanen and Harper are analogous art because they are from the same field of endeavor, i.e., tailgates.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to allow the tailgate to pivot about a horizontal axis or a vertical axis.

The motivation would have been to give the truck operator greater versatility in loading and unloading the truck bed.

Therefore, it would have been obvious to combine Smith with Ojanen to obtain the invention as specified in claims 14 and 19.

8. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ojanen in view of Seksaria et al. (US Patent 6,672,642 filed on June 11, 2002).

Ojanen disclose the tailgate of claims 1-13 and 15-17.

Ojanen does not disclose stiffeners adjacent the corners of the frame with an associated hinge attached thereto.

Seksaria et al. disclose a tailgate with a stiffener (94,95) attached to the corner of the frame with an associated hinge (101) attached thereto.

Ojanen and Seksaria et al. are analogous art because they are from the same field of endeavor, i.e., tailgates.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to include a stiffener at the corner with a hinge member attached thereto.

The motivation would have been to at reinforcement at a high load location of the tailgate.

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Therefore, it would have been obvious to combine Seskaria et al. with Ojanen to obtain the invention as specified in claim 18.

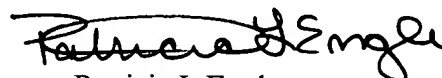
*Conclusion*

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art discloses other tailgates with reinforcements.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L Engle whose telephone number is (703) 306-5777. The examiner can normally be reached on Monday - Friday from 8:00 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, D. Glenn Dayoan can be reached on (703) 308-3102. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patricia L Engle  
Examiner  
Art Unit 3612

ple  
September 3, 2004